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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,866	09/20/2000	Brian J. Brown	S63.2-9397	1548

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VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

PREBILIC, PAUL B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,866

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-54 and 56-88 is/are rejected.
- 7) ☒ Claim(s) 57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Objections

Claims 43, 57, and 62 are objected to because of the following informalities:

With regard to claim 43, line 4, "ay" appears to be a misspelling for "at."

With regard to claims 57 and 62, these claims are objected to under 37 CFR 1.75 as being a substantial duplicate of each other. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38, 45, 60, 63, 77, 78, 80, and 81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 38 and 45, there is no clear original support for a differing "pattern" of bands, especially one band having two adjacent bands with different struts

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lengths from the one band as claimed. For this reason, the Examiner posits that the claimed invention lacks original support.

Regarding claims 60-63, 77, 78, 80, and 81, the terminology "non-parallel" does not have original support and constitutes new matter with respect to the original disclosure. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Upon further consideration of the term "non-parallel" for the interconnecting elements, the Examiner came to the conclusion that it constitutes new matter with respect to the original specification because it goes beyond the original meaning and scope of the invention as disclosed. Particularly, there is no indication that the inventors contemplated circumferentially extending interconnecting elements or serpentine extending elements even though such elements are encompassed term.

Regarding claims 63, line 2, claim 77, line 11 and claim 81, the range "at least six struts" lacks original support because only "at least three struts" (see page 4, line 10 of the specification) and six struts (see the figures) were originally disclosed. For this reason, the range of "at least six struts" goes beyond the scope of the original specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 87 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The proximal most cylindrical element is being claimed as

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defining both the proximal end of the stent and the distal end of the stent. Therefore, this language is deemed indefinite in view of the other limitations of the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 77, 78, 83, and 84 are rejected under 35 U.S.C. 102(b) as being anticipated by Palmaz (US 5,102,417). Palmaz anticipates the claim language where the at least six struts include all the struts located between interconnector (102) and another interconnector (102); see Figure 10.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 85, 86, 87, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmaz (US 5,102,417) in view of Richter et al (US 6,156,052). Palmaz meets the claim language except for the more than one middle segment as required by the present claims. However, Richter teaches that it was known to make similar stents with more than one middle segment; see Figure 2A for example. Therefore, it is the Examiner's position that it would have been obvious to make the

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Palmaz stent with more than one middle segment in order to treat a longer occluded area than would be afforded with only one middle segment.

Claims 36, 39-43, 46-56, 58-61, 63-74, 76-79, and 81-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al (EP 0540290) in view of Palmaz (US 5,102,417). Lau et al meets the claim language fully except for the non-parallel interconnector elements as claimed; see especially Figure 11. However, Palmaz is cited to show that it had been known to make connectors for adjacent stent segments at a non-parallel angle with respect to the longitudinal axis; see Figure 7-10 and the Col. 11, line 35 to Col. 13, line 18. Hence, it is the Examiner's position that it would have been obvious to make the connectors of Lau et al non-parallel with respect to the longitudinal axis for the same reasons that Palmaz did the same and so that better radial support for the vessel is provided in between stent segments than with a longitudinally aligned connector.

With regard to claims 40-42, 47-49, and 70-73, Applicants are directed to column 1, lines 22-35, column 2, lines 40-56 and column 7, lines 22-58 of Lau.

Claims 37, 38, 44, 45, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al and Palmaz as applied to claims 36, 39-43, 46-56, 58-61, 63-74, 76-79, and 81-88 above, and further in view of Lam et al (US 5,725,572). Lau et al fails to disclose varying the strut length on the proximal and/or distal segment as claimed. However, Lam et al teaches that it was known to make the struts on the proximal and distal segments longer where there are no connectors; see especially Figure 1A. Hence, it is the Examiner's position that it would have been obvious to make the struts of Lau et al longer at the connection points for the same reasons Lam et al

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does the same and in order to space adjacent segments a greater distance from each other and avoid contact thereof during longitudinal or axial flexing.

Allowable Subject Matter

Claim 57 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be

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applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
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